

## **REMARKS**

Please reconsider the present application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering the present application.

### **I. Disposition of Claims**

Claims 1-7 and 9-13 are currently pending in the present application. By way of this reply, claim 1 has been amended.

### **II. Claim Amendments**

Claim 1 has been amended to correct a minor informality. No new matter has been added by way of this amendment.

### **III. Rejection(s) Under 35 U.S.C. § 103**

Claims 1-7 and 9-13 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,790,613 issued to Tateishi (hereinafter "Tateishi") in view of U.S. Patent No. 6,313,686 issued to Kamiya (hereinafter "Kamiya"). For the reasons set forth below, this rejection is respectfully traversed.

The final Office Action of April 15, 2004 combines the teachings of Tateishi and Kamiya to arrive at the limitations of the claimed invention. However, there is no motivation or suggestion to combine the teachings of Tateishi and Kamiya. The teaching or suggestion to make the claimed combination and the reasonable expectation of success

must *both* be found in the prior art, *not* in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added). Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). In other words, there must be some objective reason to combine the teachings of the reasons. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Tateishi is directed to a cycle slip detector for a phase locked loop. *See* Tateishi, Abstract. In other words, the cycle slip detector of Tateishi detects a cycle slip in phase errors. *See* Tateishi, column 2, lines 38 – 40. Kamiya is directed to a waveform output device with an electro-magnetic interference (EMI) noise canceller. *See* Kamiya, column 1, lines 28 – 31. One skilled in the art not having the present application as a guide, presented with, for example, the circuit in Figure 5 of Tateishi and the circuit in Figure 1 of Kamiya, would find no motivation to pick certain parts of one circuit and apply them to the other considering the very different purposes of the respective circuits and the lack of any suggestion within the Tateishi and Kamiya references to incorporate the teachings of one another.

Further, applicant notes that the purported comparators **51** and **52** in Figure 1 of Kamiya are differential amplifiers that output clock signals dependent on comparison potentials, while the purported comparators **8U1** and **8L1** in Figure 5 of Tateishi output *data* signals dependent on comparison potentials. Thus, the purported comparators of Kamiya and the purported comparators of Tateishi are not simply interchangeable to arrive at the limitations of the claimed invention.

The Examiner suggests that it would have been obvious to one skilled in the art to

implement the teachings of Kamiya in Tateishi in order to generate a waveform having harmonic components that are made smaller from the junction between the PMOS transistor and the NMOS transistor disclosed by Kamiya. In response, Applicant notes that with respect to circuit 88 in Figure 5 of Tateishi, there is no disclosure of a junction between PMOS and NMOS transistors; thus, it is wholly unclear why one skilled in the art would modify Tateishi to have a feature of Kamiya when such a modification is in no way suggested or desired in either Tateishi or Kamiya.

A complete study of Tateishi and Kamiya confirms that, regardless of whether the teachings of Tateishi and Kamiya can be combined, there is no suggestion or motivation set forth (either explicitly or implicitly) in either Tateishi or Kamiya to combine the teachings of these references. Absent such a suggestion or motivation, the teachings of Tateishi and Kamiya cannot be conveniently combined to render the claimed invention obvious. Thus, independent claims 1, 7, 9, and 13 of the present application are patentable over Tateishi and Kamiya. Dependent claims are allowable for at least the same reasons. Accordingly, withdrawal of the § 103 rejections is respectfully requested.

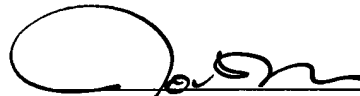
#### IV. Conclusion

The above amendments and remarks are believed to require no further prior art search. Also, Applicant believes that this reply is responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Because the amendments and remarks simplify the issues for allowance or appeal, and do not constitute new matter, entry and consideration thereof is respectfully requested.

Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 06145.003001;P4928).

Respectfully submitted,

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